

REMARKS

This responds to the Office Action mailed on January 9, 2006. Claims 1, 3-5, 7, 9-13, 15, 16, 19, 21-23, 25-27, 29, and 31-36 are amended, claims 8, 20, and 30 are canceled, and claims 37 and 38 are added; as a result, claims 1-7, 9-19, 21-29, and 31-38 are now pending in this application.

§102 Rejection of the Claims

Claims 1-4, 7, 9, 13-16, 19, 21, 23-26, 29, 31 and 35 were rejected under 35 U.S.C. § 102(e) for anticipation by Boyden et al. (U.S. Publication No. 2003/0036964 A1, hereinafter, “Boyden”).

Applicants respectfully submit that the Office Action did not make out a *prima facie* case of anticipation for at least the following reasons:

(1) The reference does not teach each and every claim element.

To anticipate a claim, the reference must teach every element of the claim. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Claim 1 recites:

A method of generating a listing in a network-based commerce system, the method including:
receiving listing identification data from a user;
searching a database of reference listing data to locate a similar listing;
receiving an indication from the user selecting the similar listing;
generating a proposed listing to present to the user, the proposed listing including the similar listing;
allowing the user to modify the listing data of the proposed listing to create a listing; and
posting the listing in a database of the network-based commerce system, wherein the listing, once posted, represents an offering of a good or service.
(Emphasis added).

Boyden describes using a computer for presenting vehicles for sale at an electronic auction by providing validated data regarding a specific vehicle that is to be presented for sale at the electronic auction. The accuracy of the data can be validated by comparing initial data

regarding the vehicle provided by the seller with corresponding reference data to produce the validated data.

Claim 1 has been amended to include substantially the same limitations of dependent claim 8. As conceded by the Office Action, Boyden does not, “explicitly teach the claimed limitations ‘searching a database of reference listing data to locate at least one similar listing; presenting the at least one similar listing to the user; monitoring user selection of a similar listing; retrieving selected listing data associated with the similar listing to generate the listing,’” as recited in claim 8. (Office Action, page 15).

Consequently, Boyden does not teach each element of claim 1 as amended. Therefore, for at least the reasons set forth above, claim 1 and the claims dependent therefrom are not anticipated by Boyden, and it is respectfully requested this rejection under § 102 be removed. The same arguments that apply to claim 1 apply to independent claims 13 and 23 and their associated dependent claims, and accordingly it is respectfully requested the rejection of these claims under § 102 be removed.

§103 Rejection of the Claims

Claims 8, 20 and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Boyden et al. in view of Linden et al. (U.S. 6,266,649, hereinafter, “Linden”).

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). To do that the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.*

The M.P.E.P. adopts this line of reasoning, stating that:

In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *M.P.E.P.* § 2142 (citing *In re*

Vaech, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

Claim 1 has been amended to include the same limitations of its dependent claim 8. Adding the teachings of Linden does not cure the deficiencies of Boyden as suggested by the Office Action.

Specifically, neither Boyden nor Linden discuss:

...searching a database of reference listing data to locate a similar listing;
receiving an indication from the user selecting the similar listing;
generating a proposed listing to present to the user, the proposed listing including the similar listing;
allowing the user to modify the listing data of the proposed listing to create a listing; and
posting the listing in a database of the network-based commerce system, wherein the listing, once posted, represents an offering of a good or service.
(Emphasis added).

Linden discusses a recommendations service to recommend items to individual users based on a set of items that are known to be of interest to a user, such as a set of items previously purchased by the user. The service is used to recommend products to users of a merchant's Web site. (Abstract).

The Office Action mischaracterizes Linden with respect to the claimed elements. The Office Action states:

Linden teaches the claimed limitations: "searching a database of reference listing data to locate at least one similar listing" as to generate a set of recommendations for a given user, the service retrieves from the table the similar items lists corresponding to items already known to be of interest to the user, and then appropriately combines these lists to generate a list of recommended items. The above information shows that the table is searched for retrieving the similar items lists corresponding to items already known to be of interest to the user. The set of recommendations is represented as at least one similar listing (col. 3, lines 7-10). (Office Action, page 15). (Emphasis added).

and

...generating a set of recommendations for a given user by retrieving from the table the similar items lists corresponding to items already known to be of interest to the user, displaying the set of recommendations and select a link associated with one of the recommended items to view the product information page for that item and selecting a link associated with one of the recommended items to view the product information page for that item to Boyden's system in order to save time for searching a particular type or category of item and further to provide the most relevance information based on user's selection.

(Office Action, page 16 to top of page 17). (Emphasis added).

However, Linden's discussion of searching a database is confined to a service to generate recommendations of products that a user may be interested in based on such information as prior purchases, then displays those recommended products as selectable links that when selected provide additional information on the product for purchase via a merchant website.

In contrast, claim 1 recites, "searching a database of reference listing data to locate a similar listing," "receiving an indication from the user selecting the similar listing," and "generating a proposed listing to present to the user, the proposed listing including the similar listing." While the recommended list in Linden can be a list of products based on the user's prior purchases, it is certainly not a proposed listing which may be modified by the user to create a listing, which once posted, represents an offering of a good or service.

Combining Boyden's method of accurately validating data from a user (seller) by comparing initial data regarding the vehicle provided by the seller with corresponding reference data to produce validated data to what is disclosed in Linden does not cure Linden's defects.

In summary, combining the teachings of Boyden with the teachings of Linden does not render claim 1 obvious for at least the reasons set forth above. Therefore, claim 1 and all claims dependent therefrom are patentable over the cited art and it is respectfully requested this rejection under § 103 be removed. The arguments provided above with respect to claim 1 also apply to independent claims 13, and 23 and their associated dependent claims. Consequently, these claims are also patentable over Boyden in view of Linden and it is respectfully requested any rejection to these claims under § 103 be removed.

Claims 5-6, 17-18 and 27-28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Boyden et al. in view of Erdelyi (U.S. 6,631,522, hereinafter, "Erdelyi"); claims 10, 22 and 32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Boyden et al. in view of Maze et al. (U.S. 6,216,264, hereinafter, "Maze"); claims 11-12 and 33-34 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Boyden et al. in view of Ortega et al. (U.S. 6,144,958, hereinafter, "Ortega"); and claim 36 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Boyden et al. in view of Bezos et al. (U.S. 6,029,141, hereinafter, "Bezos").

However, Boyden, alone or in combination with Erdelyi, Maze, Ortega or Bezos do not render claim 1 obvious because none of those reference disclose, *inter alia*, searching a database of reference listing data to locate at least one similar listing; receiving an indication of a selection of a similar listing; retrieving selected listing data associated with the similar listing; generating a proposed listing to present to the user, the proposed listing including the at least one similar listing, as recited in claim 1.

Therefore, claim 1 and all claims dependent therefrom are patentable over these cited references. Additionally, the arguments provided above with respect to claim 1 also apply to independent claims 13 and 23 and there associated dependent claims.

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.116 – EXPEDITED PROCEDURE

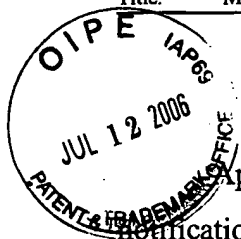
Serial Number: 10/648,125

Filing Date: August 25, 2003

Title: METHOD AND SYSTEM TO GENERATE A LISTING IN A NETWORK-BASED COMMERCE SYSTEM

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CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance and
reaffirmation to that effect is earnestly requested. The Examiner is invited to telephone
Applicants' attorney at 408-278-4045 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account
No. 19-0743.

Respectfully submitted,

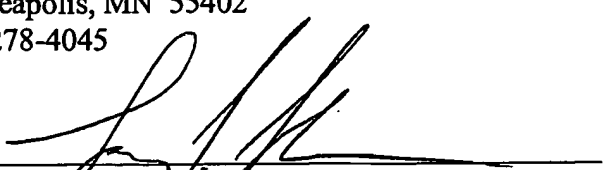
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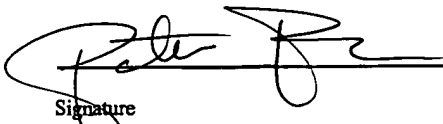
Date July 10, 2006

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop RCE, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 10 day of July, 2006.

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